

U.S. Patent Application Serial No. **10/807,174**
Amendment filed June 30, 2006
Reply to OA dated March 31, 2006

REMARKS

Claims 1-7 are pending in this application.

The support for the amendment to claim 1 is as follows: p.14, lines 13-17. The applicants respectfully submit that no new matter has been added. It is believed that this Amendment is fully responsive to the Office Action dated **March 31, 2006**.

Claim 1 is rejected under 35 USC 102(b) as being anticipated by Yamamura et al (US 4,778,722) substantially as set forth in the 10/28/2005 Office Action. (Office Action, p.3)

Claim 1 has been amended to exclude polymetallosiloxane. The support for such an amendment is the disclosure on p.14, lines 13-17 of the specification:

Normally a siloxane resin therefor is prepared by heating a mixture containing a tetraalkoxysilane, an alkyltrialkoxysilane, and/or a trialkoxysilane, as well as a solvent, followed by vaporizing a predetermined amount of alcohol.

Amending claim 1 to exclude polymetallosiloxane would be commensurate in scope with our previous arguments, as follows:

Yamamura is discloses an inorganic fiber having a composition of (1) a polycarbosilane mixed with (2) polymetallosiloxane with a main-chain skeleton composed of metalloxane units of the formula (-M-O-) wherein M represents Ti or Zr (col.3, lines 20-31). All of the working examples disclosed in the patent use the polymetallosiloxane fibers created in Production Example 1 and 2 (col.11).

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In light of the fact that the composition of Yamamura contains a polymetallosiloxane with Ti or Zr atoms as the second main component, and the applicants claimed invention does not contain a polymetallosiloxane, it is impossible for the chemically different composition of Yamamura to anticipate the claimed a siloxane resin; a silicon compound and solvent composition.

It is respectfully urged that this rejection be reconsidered and withdrawn.

Claims 1-3, and 5-7 are rejected under 35 USC 102(a) as being anticipated by JP2001-127152 substantially as set forth in the 10/28/2005 Office Action. (Office Action, p.3)

In order to make clear that claims 1-3 and 5-7 are not anticipated by JP'152 the following showing is provided:

The issue is how to calculate the C/Si ratio. The polycarbosilane in formula 3 of JP'152 has one silicon atom and one carbon atom (as shown in the form of a methylene group on the right side of the silicon). Therefore the C/Si ratio is 1/1, clearly indicating that the compound is out of the scope of the claimed invention.

To compare, in the structure of $[-\text{Si}(\text{R}_4, \text{R}_5)-\text{R}_6-]_p$ in *claim 2*, for example, the number of Si is one. Therefore, if R6 has two carbons in the chain (please note that only carbons in the main chain should be counted), the C/Si ratio will be 2/1. R4 and R5 do not influence on the C/Si ratio (since they are not in the main chain).

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R6 is defined to have a carbon number from 1 to 3. Accordingly, if R6 has only one carbon atom in the chain, the C/So ratio is 1/1 which is outside the scope of the claimed invention.

However, since there may be more than one type of R6 in the above structure of [-Si(R₄, R₅)-R₆-]_p, the presence of such R6 does not necessarily mean that the C/Si ratio is 1/1. If, for example, there are two types of atoms in the chain, in the same amount, the C/Si ratio is 2/1, which is within the scope of the claimed invention.

But, any apparent similarity of formula 3 of JP'152 and formula 3 of *claim 2* is not proper for denying the patentability of the C/Si ratio of claim 1 of the present invention.

It is requested that this rejection be reconsidered based on the showing of the number ratio issue.

Claim 4 is rejected under 35 USC 103(a) as being unpatentable over JP 2001-127152 as applied to claim 1 above, further in view of JP 64-009231 substantially as set forth in the 10/28/2005 Office Action. (Office Action, p.3)

Claim 1 has been amended as explained above thereby making the rejection of claim 4, a dependent claim now moot. It is respectfully requested that this rejection be reconsidered and withdrawn.

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Claims 1-3, and 5-7 are rejected under 35 USC 103(a) as being unpatentable over Rutherford et al.(US 6,318,124) in view of JP2001-127152. (Office Action, p.3)

The Office Action admits in this new rejection that Rutherford does not disclose the coating composition made from a specific combination of a siloxane resin and a polycarbosilane.

Rutherford is a general reference which lacks the disclosure of a specific combination. Since claim 1 has been amended to recite a more specific siloxane resin which is not disclosed in either Rutherford or JP'152, it is logically impossible for the combination of references to teach the invention as now claimed. The combination of references lack information which would suggest the claimed invention.

Therefore it is requested that the rejection be reconsidered and withdrawn.

Claim 4 is rejected under 35 USC 103(a) as being unpatentable over Rutherford et al (US 6,318,124) in view of JP 2001-127152 as applied to claim 1 above, further in view of JP 64-009231. (Office Action, p.5)

From the explanation above of the rejection of claim 4, under JP'152 and JP'231, it appears that Rutherford does not provide any motivation to combine the references to make obvious the invention of claim 4. Therefore, in light of the claim amendments and above showing, it is respectfully requested that this rejection be reconsidered and withdrawn.

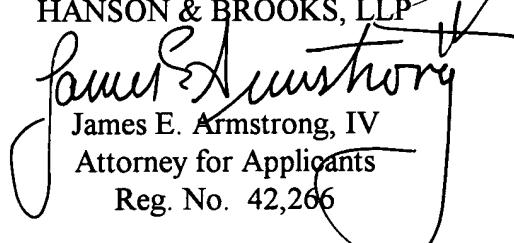
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In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,
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